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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,149	10/12/2000	John J. Sie	19281-000900US	8623
20350 7590 06/30/2006			EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			BROWN, RUEBEN M	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			2623	
DATE MAILED: 06/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/687,149	Applicant(s) SIE ET AL.	
	Examiner Reuben M. Brown	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/23/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18-20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-20 & 23-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 18 & 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner notes that the applicant claims and argues that the 'content provider stores the second set of programs on a server located on a STB'. However, this feature is not understood, since the server is located at the server, and not at the STB. Therefore, while the server can choose or select programs to be stored at the STB, but the server itself, does not actually store the programs at the STB. Examiner has reviewed the portions of the specification cited by applicant

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in support of the amendments, however, these citations do not support, 'storing, by a content provider'.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail, (U.S. Pat # 6,614,987), in view of Russo, (U.S. Pat # 5,619,247).

Considering claim 1, the claimed method for distributing programming, the method comprising:

'transmitting a first set of programs in real time according to a schedule', is met by the disclosure of Ismail that the system broadcasts regular TV programs to viewers, see col. 3, lines 18-31; col. 9, lines 60-66; col. 10, lines 15-20, which discusses subscribers choosing particular broadcast programming based on channel and/or time of broadcast.

‘storing a second set of programs on a server located on a set-top box local to a user, such that at least one of the first set of programs have a counterpart in the second set of programs, wherein the counterpart in the second set of programs is substantially identical to the at least one of the first set of programs’, is met by the disclosure in Ismail that the system records a plurality of broadcast programs in a subscriber equipment, based on one or more of a subscriber’s direct selection; a profile generated based on inferences taken from the instant subscriber’s viewing preferences and/or category-value pairs given to programs that match category-value pairs specified by the user, see col. 3, lines 9-20; col. 3, lines 65-67 thru col. 4, lines 1-34; col. 6, lines 18-52; col. 10, lines 3-31.

As for the further amended claim of, ‘content provider stores the second set of programs on a server located on a STB’, Ismail teaches that the program selection for storage is done at the STB. However, Russo teaches pre-loading a group of movies at a STB, such that the selection of these movies is done at the headend, col. 9, lines 65-67 thru col. 10, lines 1-10. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail with the feature having the choices for program recording being done at the headend, as taught by Russo at least for the advantage of having the content maintain control over which subscribers receive which movies for storage.

As for the additional feature of the content provider transmitting the first set of programs based on a programming schedule, Russo also teaches that programs for storage may be selected from schedule information, Abstract; col. 4, lines 35-45; col. 9, lines 37-45.

‘playing at least one of the second set of programs from the server under the control of the user’, reads on the discussion in Ismail that the subscriber can control the playback of broadcast programs recorded on the subscriber equipment, using VCR-like functions, col. 3, lines 20-30; col. 13, lines 50-67 thru col. 14, lines 1-18.

Considering claim 2, the claimed feature of ‘switching from transmission of a particular program according to a schedule of programming to transmission of a counterpart to the particular program from the server’, reads on the discussion in Ismail that when a subscriber is watching a currently broadcast program, that the subscriber has the option of recording the instant currently broadcast program onto the subscriber equipment (for instance, in order to watch a different program), see col. 13, lines 50-67. When the instant subscriber desires to view the broadcast program that was previously being viewed, that instant program can be optionally replayed from its recording on the subscriber equipment. Thus Ismail teaches switching from the transmission of a broadcast program, to its counterpart stored on subscriber equipment.

Considering claims 3-4, the disclosure of Ismail teaches that the switching is executed optionally based on the subscriber’s command, which begins playing of the recorded program, col. 13, lines 50-67 thru col. 14, lines 1-7.

Considering claim 5, the claimed subject matter reads on the discussion in Ismail, that when the resume button is pressed, the system begins playing the recorded program from the

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point at which the currently broadcast program was paused, see col. 13, lines 60-67 thru col. 14, lines 1-7.

Considering claims 6-7, see col. 14, lines 8-20. Ismail teaches the use of a remote control, col. 13, lines 61-67.

3. Claims 8, 11 & 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail & Russo, in view of Garfinkle, (U.S. Pat # 5,530,754).

Considering claims 8 & 11, even though the subscriber in Ismail is able to select programs that are stored on the subscriber equipment, the reference appears to merely teach that the access the program by changing channels, instead of by interacting with a 'menu of programs', as claimed. Nevertheless, Garfinkle which is in the same filed of endeavor, teaches that set a set of programs from a remote server may be stored at a subscriber equipment, and that a menu or catalog may also be supplied to the subscriber in order to select the desired program, col. 3, lines 5-55. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail with the feature of transmitting a menu of programs stored at the subscriber equipment as taught by Garfinkle, at least for the well-known improvement of assisting the user program selection (col. 3, lines 54-57), using a program guide instead of the user checking each channel individually by changing the channel.

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Considering claims 13-14, in Ismail (col. 3, lines 9-30) & Garfinkle (col. 4, lines 12-25) the at least one of the second set of programs can be played from its beginning, which reads on the claimed subject matter.

4. Claims 9-10 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail & Russo, in view of Garfinkle as applied to claims 8 & 11 above, and further in view of Edwards, (U.S. Pat # 5,604,528).

Considering claims 9-10 & 12, Garfinkle does not discuss the claimed feature of verifying whether a user is authorized to access programs from a server. However Edwards, which is in the same field of endeavor of VOD or pay-per-view services, teaches having CATV subscribers in at least two categories, with respect to premium channels, namely, regular subscription and periodic subscription. The subscribers with a periodic subscription are generally denied access to the premium channels, unless they sign up for a period of time, such as the weekend, or they are granted a promotional free period, Abstract; col. 4, lines 11-40; col. 10, lines 11-67 & col. 11, lines 1-40. Therefore, Edwards reads on determining whether a subscriber is authorized to access content; also see col. 18, lines 1-15. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail & Garfinkle with the feature of verifying user authorizations to access content, for the known purpose of ensuring that proper payments and authorizations are given, before access to certain content, such as premium channels is provided to a particular user; see col. 1, lines 41-60; col. 2, lines 37-67.

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5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail & Russo, as applied to claim 1 above, and further in view of Edwards.

Considering claim 15, Ismail does not discuss the claimed feature of verifying whether a user is authorized to access programs from a server. However Edwards, which is in the same filed of endeavor of VOD or pay-per-view services, teaches having CATV subscribers in at least two categories, with respect to premium channels, namely, regular subscription and periodic subscription. The subscribers with a periodic subscription are generally denied access to the premium channels, unless they sign up for a period of time, such as the weekend, or they are granted a promotional free period, Abstract; col. 4, lines 11-40; col. 10, lines 11-67 & col. 11, lines 1-40. Therefore, Edwards reads on determining whether a subscriber is authorized to access content; also see col. 18, lines 1-15. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail with the feature of verifying user authorizations to access content, for the known purpose of ensuring that proper payments and are authorizations are given, before access to certain content, such as premium channels is provided to a particular user; see col. 1, lines 41-60; col. 2, lines 37-67.

6. Claims 18-19 & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail & Russo, in view of Payton, (U.S. Pat # 5,790,935).

Considering claims 18 & 23, the claimed steps of a method for distributing programming that correspond with subject matter mentioned above in the rejection of claim 1 is likewise analyzed. Claim 18 includes the additionally recited feature of 'detecting a request from the user for program control over one of the programs in the first set of programs; determining whether the requested program has a counterpart program stored on the server'. Ismail teaches detecting when the subscriber requests a control of a currently broadcast program, such as Pause, see col. 13, lines 50-60. Ismail responds by in fact Pausing the currently broadcast program and storing the instant currently broadcast program on the subscriber's equipment, so that it may be accessed when desired by the subscriber. However, Ismail does not explicitly state that the system would 'determine if the requested program is already stored on the local server'.

Nevertheless, Payton, which is in the same field of endeavor of local storage of programming, teaches that a set of programs may be broadcast and stored on the local storage. When the subscriber attempts to access a program, the system first checks to see if the program is stored on the local server, Fig. 3b. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail with the feature determining whether a requested program is already stored on a local storage device, at least for the improvement of reducing the amount of necessary two-way traffic, as taught by Payton, see col. 6, lines 20-35; col. 7, lines 11-35.

Considering claim 19, both Ismail & Payton include a wireless remote control.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail & Payton as applied to claim 18 above, and further in view of Edwards.

Considering claim 20, Ismail does not discuss the claimed feature of verifying whether a user is authorized to access programs from a server. However Edwards, which is in the same filed of endeavor of VOD or pay-per-view services, teaches having CATV subscribers in at least two categories, with respect to premium channels, namely, regular subscription and periodic subscription. The subscribers with a periodic subscription are generally denied access to the premium channels, unless they sign up for a period of time, such as the weekend, or they are granted a promotional free period, Abstract; col. 4, lines 11-40; col. 10, lines 11-67 & col. 11, lines 1-40. Therefore, Edwards reads on determining whether a subscriber is authorized to access content; also see col. 18, lines 1-15. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ismail with the feature of verifying user authorizations to access content, for the known purpose of ensuring that proper payments and are authorizations are given, before access to certain content, such as premium channels is provided to a particular user; see col. 1, lines 41-60; col. 2, lines 37-67.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Ottesen Teaches storing programs at a STB.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Reuben M. Brown